



Paper No. 11

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OFFICE OF PETITIONS

In re Application of
Blackburn, et al.
Application No. 09/993,342
Filed: November 5, 2001
Attorney Docket No. A-68718-4/RFT/RMS/RMK
For: DEVICES AND METHODS FOR BIOCHIP
MULTIPLEXING

ON PETITION

This decision is in response to (1) the petition under 37 CFR 1.47(a), filed July 12, 2002 (certificate of mailing date July 8, 2002) and (2) a "Request for Corrected Filing Receipt," filed July 12, 2002 (certificate of mailing date July 8, 2002). The "Request for Corrected Filing Receipt" will be treated as a petition under 37 CFR 1.181 requesting alteration of the Office of Initial Patent Examination's decision regarding priority data.

The petition under 37 CFR 1.47(a) is **granted**.

The petition under 37 CFR 1.181 is **dismissed**.

Petitioner has shown that the non-signing inventor, Stephen D. O'Conner has refused to join in the filing of the above-identified application after having been presented with the opportunity to view the application papers. Specifically, petitioners have submitted a letter signed by Stephen D. O'Conner that states that he does not wish to review the application and will not sign the declaration. Petitioner has submitted a declaration in substantial compliance with 37 CFR 1.63.

It is noted that the information/name of Inventors Olsen and Pietri contain non-initialed and non-dated changes. 37 CFR 1.52(c) states that "[a]ny interlineation, erasure, cancellation or **other alteration** of the application papers filed should be made on or before the signing of the accompanying oath or declaration pursuant to 1.63..." (emphasis added). declaration. The Office will not consider whether noninitialed and or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration. See MPEP 605.04(a). For this reason, a newly executed supplemental declaration by Inventors Olsen and Pietri, listing all 9 inventors and the proper information for all parties is required. **Petitioners should submit a supplemental declaration within two (2) months of the mail date of this decision.**

This application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the nonsigning inventor at the address given in the petition. Notice of the filing of this application will

also be published in the Official Gazette.

Petitioner filed a "Request for Corrected Filing Receipt," on July 12, 2002 (certificate of mailing date July 8, 2002), requesting that the above-identified application's priority data be altered.

Petitioners argue that the filing date of the provisional application from which the above-identified application claims priority is incorrect. Petitioner states that the "Priority Data as Claimed by Applicant" portion of the receipt should read, "THIS APPLN CLAIMS BENEFIT OF 60/145,840 11/03/2000-." Petitioner contends that the filing date is incorrect.

This assertion is wrong. Provisional application no. 60/145,840 has a filing date of July 27, 1999. More salient to this analysis, provisional application no. 60/145,840 is a completely unrelated application to the above-identified application.

A review of the specification of the above-identified application reveals that applicant claimed benefit of the same unrelated provisional application (60/145,840).

Applicant should have claimed benefit of provisional application no. 60/245,840. Provisional application no. 60/245,840 has a filing date of November 3, 2000. Provisional application no. 60/245,840 is the provisional application titled, "DEVICES AND METHODS FOR BIOCHIP MULTIPLEXING."

The petition under 37 CFR 1.181 to alter the above-identified application's priority data is **DISMISSED**.

This application was filed after November 29, 2000 and is subject to the rule that priority claims for the benefit of a prior filed provisional application must be submitted within the later of 4 months from the actual filing date of the nonprovisional application or 16 months from the filing date of the prior application for which a claim for priority is made. 37 CFR 1.78(a)(5).

Petitioner did not submit a priority claim for the correct provisional application until after the 4 month/16 month deadline expired.

The Office requires petitioner to submit a petition under 37 CFR 1.78(a)(6) within two (2) months of the mail date of this decision. The petition must be accompanied by a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5) and the date the claim was filed was unintentional and a preliminary amendment correcting the reference to the related provisional application. In addition, the petition must be accompanied by the \$1,300.00 fee.

Further correspondence with respect to this matter should be addressed as follows:

By mail until 05/01/03: Commissioner for Patents
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By mail on or after 05/01/03: Mail Stop PETITION
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Telephone inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.



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